



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

JUN 07 2001

TECH CENTER 1600 2900

Applicant: Kenneth Rhodes and Wenqian An

Serial No.: 09/400,492

Filed: September 21, 1999

For: METHODS FOR TREATING
CARDIOVASCULAR DISORDERS

Attorney Docket No.: MNI-069CP

Group Art Unit: 1646

Examiner: Murphy, J.

RECEIVED

JUN 07 2001

TECH CENTER 1600 2900

Commissioner for Patents
Washington, D.C. 20231

Certificate of First Class Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The Commissioner for Patents, Washington, D.C. 20231 on the date set forth below.

Date of Signature and of Mail Deposit

By:

Amy E. Mandragouras
Attorney for Applicants

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the restriction requirement set forth in the Office Action dated March 28, 2001(Paper No. 7). A request for the appropriate extension of time in which to respond is being filed concurrently herewith. The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claims 1-3, 11-12 and 15-16, drawn to a method of compound identification suitable for treatment wherein the PCIP is 9q, classified in class 435, subclass 7.2.
- II. Claims 1 -3, 11 - 12 and 15-16, drawn to a method of compound identification suitable for treatment wherein the PCIP is 8t, classified in class 435, subclass 7.2.
- III. Claims 1 -3, 11 - 12 and 15- 16, drawn to a method of compound identification

suitable for treatment wherein the PCIP is pl9, classified in class 435, subclass 7.2.

- [IV]. Claims 4, 11 and 15- 16 drawn to a method for treating a cardiovascular disorder wherein the target is PCIP 9q, classified in class 514, subclass 2.
- [V]. Claims 4, 11 and 15- 16 drawn to a method for treating a cardiovascular disorder wherein the target is PCIP 8t, classified in class 514, subclass 2.
- VI. Claims 4, 11 and 15- 16 drawn to a method for treating a cardiovascular disorder wherein the target is PCIP pl9, classified in class 514, subclass 2.
- VII. Claims 5-11 and 15- 16, drawn to a method of determining if a subject is at risk of, or suffering from cardiovascular disorder wherein the PCIP gene altered is PCIP 9q, classified in class 435, subclass 6.
- VIII. Claims 5- 11 and 15- 16, drawn to a method of determining if a subject is at risk of, or suffering from cardiovascular disorder wherein the PCIP gene altered is PCIP 8t, classified in class 435, subclass 6.
- IX. Claims 5- 11 and 15- 16, drawn to a method of determining if a subject is at risk of, or suffering from cardiovascular disorder wherein the PCIP gene altered is PCIP pl9, classified in class 435, subclass 6.

Applicants hereby elect the Group I invention (claims 1-3, 11-12 and 15-16, directed to a method of compound identification suitable for treatment wherein the PCIP is 9q) for prosecution in this application, *with traverse*.

Applicants respectfully traverse the restriction between the inventions of Groups I-III. Applicants respectfully submit that Groups I-III are all directed to the same method for identifying compounds. Contrary to the Examiner's assertions, there are no "materially different process steps" nor is there a "materially different purpose" for the method of these three Groups. The only difference is in the starting material. The 8t gene of Group II is an amino terminal

splice variant of the 9q gene (a/k/a KChIP2) of Group I and these two sequences share a 75% sequence identity. It is, thus, clear that a search based on the 9q sequence will identify references that relate to the 8t sequence as well. Likewise, the p19 gene (a/k/a KChIP3) shares a 70% sequence identity with 9q and, being a potassium channel modulator, has the same functional properties as 9q. It is, therefore, reasonable to expect that a search based on the 9q sequence will identify references that relate to the p19 sequence as well.

Applicants respectfully submit that a sufficient search and examination with respect to the inventions of Groups I-III can be made without serious burden on the Examiner. As the M.P.E.P. states:

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803.

The inventions of Groups I-III have all been classified in Class 435, subclass 7.2. As such, the searches with regard to these inventions would be co-extensive and would not involve a serious burden on the Examiner. Applicants therefore request that the Examiner examines Groups I-III.

Applicants reserve the right to traverse the restriction between the non-elected groups in this or a separate application.

It is also the Applicants' position that Groups I-III should be re-grouped into a single Group and that a species election for searching purposes would be more appropriate in this situation.

It is the Applicants' understanding that under 35 U.S.C. §121, an election of a single species for prosecution on the merits is required, to which the claims will be restricted if no generic claim is finally held allowable. Applicants submit that claim 1 is generic. Applicants further understand that upon the allowance of a generic claim, Applicants will be entitled to

consideration of claims to additional species which are written in dependent from or otherwise include all the limitations of an allowed generic claims as provided by 37 C.F.R. §1.41 *et seq.*

SUMMARY

If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' Attorney at (617) 227-7400.

Respectfully submitted.



Amy E. Mandragouras
Attorney for Applicants
Reg. No.: 36,207

LAHIVE & COCKFIELD, LLP
28 State Street
Boston, MA 02109
Tel. (617) 227-7400

Dated: May 29, 2001